1. **Summary of the Office Action**

Claims 1, 5, 12 and 9 – 13, 16, 19 – 21 & 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lanning. (U.S. Patent No. 5,787,285).

Claims 2 – 4, 14, 15, 17, 18, 22 & 23 are rejected under 35 U.S.C 103(a) as being unpatentable over Lanning (U.S. Patent No. 5,787, 285) and further in view of Barritz et al. (U.S. Patent No. 6,519,766).

Claims 6 and 25 are rejected under 35 U.S.C 103(a) as being unpatentable over Lanning (U.S. Patent No. 5,787, 285) as applied in claims 5 and 24, in view of Adams (5,465,258).

Claims 7, 8, 26 and 27 are rejected under 35 U.S.C 103(a) as being unpatentable over Lanning (U.S. Patent No. 5,787, 285) as applied in claim 5, and 24 in view of Dean et al. 6,070,009.

2. **Response to § 102 Rejections**

Claim 1 reads as follows:

> 1. A method comprising:
> obtaining performance data on **a first program run on a first system configuration of a first system** and obtaining performance data on **the first program run on a second system configuration of the first system,** the performance data including a separate system profile for the program corresponding to the first and second system configurations, the performance data obtained from a tool; and
> automatically sorting the performance data for each profile to allow for comparison between profiles.

Lanning discloses a system that optimizes executable code sequences for various operational environments or modes. (Lanning, 1: 9-11.) Lanning defines an environment as the conditions created by a group of users with similar usage patterns that effect the way in which the program runs. (Lanning, 1: 54-57.) As an example, Lanning refers to a telephone switching system that serves both rural and urban communities, where urban users generally place more credit card calls, conference calls and international calls in comparison to the rural user. (Lanning, 1: 58-62) Therefore, continues Lanning, since the usage patterns of the rural and urban user is different, they create distinct operational environments. (Lanning, 1: 62-64.) The examples of different modes in Lanning include busy hour operations and off-hour operations of a telephone switching system. (Lanning, 1: 65 – 2: 4.) Thus, neither "environment" nor "mode" in Lanning is related to the configuration of a system on which the application program is running.

The Office action cites PROFILE1 and PROFILE 2 of Fig. 3 in Lanning to show "obtaining performance data on **a first program run on a first system configuration of a first system** and obtaining performance data on **the first program run on a second system configuration of the first system**" recited in claim 1. It is submitted that the profile data structures 1 and 2 of Fig. 3 that contain *a plurality of input conditions used to exercise the application program in a particular operational environment or mode* (Lanning, 4: 33-46.) are not related to **the configuration of the system on which the subject program is running**. In fact, although the application in Lanning can be configured to run in a particular operational environment or mode (by utilizing different input conditions), there is no indication in Lanning that there is ever any change to the configuration of the system on which the application is being run. Thus, Lanning fails to disclose or suggest the feature of "obtaining performance data on **a first program run on a first system configuration of a first system** and obtaining performance data on **the first program run on a second system configuration of the first system**, " as recited in claim 1. Therefore, claim 1 and its dependent claims are patentable in view of Lanning.

Claim 19 recites a tool "to obtain performance data on **a first program run on a first system configuration of a system** and to obtain performance data on **the first program run on a second system configuration of the system**." Thus, claim 19 and its dependent claims are patentable in view of Lanning for at least the reasons articulated with respect to claim 1.

3.   **Response to § 103 Rejections**

The Office action combines Lanning with Barritz to reject claims 2 – 4, 14, 15, 17, 18, 22 & 23 under 35 U.S.C 103(a).

Barritz is directed at a computer program providing an output, which is used to profile one or more operational characteristics of another computer program. (Barritz, Abstract.) Barritz, whether considered separately or in combination with Lanning, fails to disclose or suggest "obtaining performance data on a first program run on **a first system configuration of a first system** and obtaining performance data on the first program run on **a second system configuration of the first system**," as recited in claim 1. Claims 2-4, 14, 15, 17, and 18 include this limitation by virtue of being dependent on claim 1. Thus, claims 2-4, 14, 15, 17, and 18 are patentable over the combination of Lanning and Barritz.

Barritz, whether considered separately or in combination with Lanning, also fails to disclose or suggest a tool "to obtain performance data on a first program run on **a first system configuration of a system** and to obtain performance data on the first program run on **a second system configuration of the system**," as recited in claim 19. Claims 22 and 23 include this limitation by

virtue of being dependent on claim 19. Thus, claims 22 and 23 are patentable over the combination of Lanning and Barritz.

The Office action combines Lanning with Adams to reject claims 6 and 25 under 35 U.S.C 103(a).

Adams is directed at performance evaluation tool comprising an analyzer module for analyzing a binary image of said program and making modifications necessary to measure performance; a kernel for measuring and storing runtime performance information; and a post processor for processing said runtime performance information, correlating it with static information, and displaying resulting information to a user. (Adams, Abstract.) Adams, whether considered separately or in combination with Lanning, fails to disclose or suggest "obtaining performance data on a first program run on **a first system configuration of a first system** and obtaining performance data on the first program run on **a second system configuration of the first system**," as recited in claim 1. Claim 6 includes this limitation by virtue of being dependent on claim 1. Thus, claim 6 is patentable over the combination of Lanning and Adams.

Similarly, Adams, whether considered separately or in combination with Lanning, fails to disclose or suggest a tool "to obtain performance data on a first program run on **a first system configuration of a system** and to obtain performance data on the first program run on **a second system configuration of the system**," as recited in claim 19. Claim 25 includes this limitation by virtue of being dependent on claim 19. Thus, claim 25 is patentable over the combination of Lanning and Adams.

The Office action combines Lanning with Dean to reject claims 7, 8, 26, and 27 under 35 U.S.C 103(a).

Dean is directed at a method for estimating execution rates of program executions paths. (Dean, Abstract.) Dean, whether considered separately or in combination with Lanning, fails to disclose or suggest "obtaining performance data on a first program run on **a first system configuration of a first system** and obtaining performance data on the first program run on **a second system configuration of the first system,**" as recited in claim 1. Claims 7 and 8 include this limitation by virtue of being dependent on claim 1. Thus, claims 7 and 8 are patentable over the combination of Lanning and Dean.

Dean, whether considered separately or in combination with Lanning, fails to disclose or suggest a tool "to obtain performance data on a first program run on **a first system configuration of a system** and to obtain performance data on the first program run on **a second system configuration of the system,**" as recited in claim 19. Claims 26 and 27 include this limitation by virtue of being dependent on claim 19. Thus, claims 26 and 27 are patentable over the combination of Lanning and Dean.

4. Conclusion

Having tendered the above remarks and amended the claims as indicated herein, Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional fees due in connection with this communication, please charge our deposit account no. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Elena Dreszer at (408) 947-8200 ext. 209.

Respectfully submitted,

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